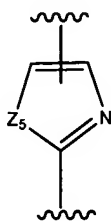


REMARKS**Claim Amendment**

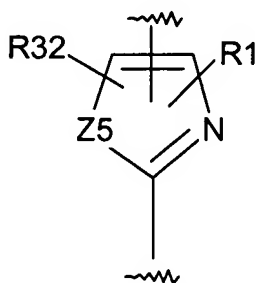
Claims 5, 9, 19, 20, 28, 29, 38, 39 are cancelled.

Claim 4 is amended to be drawn to the invention elected in the Amendment filed on February 26, 2008 in response to the restriction requirement. Additionally, Claim 4 is amended to define variable T1 as a moiety of formula



Claim 4 is further amended to recite the optional substituents on T1. The lists of allowable values of such substituents are the lists of values of the original variables R1 and R32, with the exception of hydrogens and C1-C8 alkyls. Support for this amendment comes, in part, from the portion of the instant specification on page 14, lines 6-12, reproduced below:

In Structural Formulas depicted herein, when more substituents are indicated on a group than are chemically possible, e.g., when T1 is



and Z5 is S or O, one skilled in the art will appreciate that excess substituents are intended in the alternative, e.g., that T1 above can be substituted with a substituent selected from R1 and R32.

Claim 4 is also amended to delete the definitions of variables not in use. Finally, Claim 4 is amended to delete the term "solvate".

Claims 6 and 7 are amended to be drawn to the elected subject matter and to fall within the scope of Claim 4 as amended, on which Claims 6 and 7 depend.

Claim 10 is amended to depend on Claim 7.

Claim 46 is amended to delete the non-elected subject matter and is recast in independent form.

Claim 50 is amended to delete the term “modulating” and to insert the term “activating”.

Claim 101 is amended to delete the non-elected subject matter and to delete the term “solvate”.

New Claim 115 is added. Claim 115 is based on Claim 50 and is drawn to the subject matter of Claims 46.

Rejection Under 35 U.S.C. §102(e)

Claims 4, 6, 7, 9-11, 50, and 53-55 are rejected under 35 U.S.C. §102(e) as being anticipated by WO 03/074051 (“Cheng”). The Examiner referred to compound 23 of Example 23 of Cheng.

Applicants amended base Claim 4 to recite the optional substituents on T1. The lists of permissible values of such substituents exclude hydrogen and C1-C8 alkyls. As such, the compounds of Claim 4 as amended are clearly novel over Cheng, whose general formula (1) (see, *e.g.*, the abstract) requires that the moiety corresponding to the variable T1 of pending Claim 4 be substituted by a methyl. Applicants also direct the Examiner’s attention to the examples of Cheng. In all exemplified compounds, including compound 23, the moiety corresponding to T1 of pending Claim 4 is methyl-substituted.

Moreover, Claim 4 and claims dependent thereon are also non-obvious in view of Cheng. Indeed, in a recent decision by the U.S. Court of Appeals for the Federal Circuit, Takeda Chemical v. Alphapharm, 492 F.3d 1350, 83 U.S.P.Q.2D 1169 (C.A.F.C. 2007), the court confirmed a well-established principle of “chemical obviousness”:

[...] in order to find a prima facie case of unpatentability in such instances, a showing that the "prior art would have suggested making the specific molecular modifications necessary to achieve the claimed invention" was also required. *Id.* (citing *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992); *Dillon*, 919 F.2d 688; *Grabiak*, 769 F.2d 729; *In re Lalu*, 747 F.2d 703 (Fed. Cir. 1984). Emphasis added.)

Applicants further note that the C.A.F.C. opinion in Takeda was issued after the decision by the Supreme Court in KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007).

In the instant case, there is no suggestion in Cheng to modify his compounds by replacing the methyl by any other substituents. Indeed, *every single exemplified compound* possesses the methyl substituent. Thus, there is no suggestion or motivation in Cheng to substitute the moiety corresponding to the variable T1 of pending Claim 4 even with *a homologous* group, much less with a non-homologous groups, such as the groups recited in Claim 4 as amended.

Reconsideration and withdrawal of the restriction requirement is requested.

Rejection of Claims 4 and 101 under 35 U.S.C. §112

Claims 4 and 101 are rejected under 35 U.S.C. §112, first paragraph, as not enabled for the recitation of the term “solvate”.

Applicants amended Claims 4 and 101 to delete this term.

Reconsideration and withdrawal of the restriction requirement is requested.

Rejection of Claim 50 under 35 U.S.C. §112

Claim 50 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner objected to the term “modulating” as not defined.

Applicants amended Claim 50 to delete the term “modulating” and to insert the term “activating”. Applicants note that the compounds of the present invention are agonists of Peroxisome Proliferator Activated Receptors (PPARs). This follows from the description on page 1, lines 18-19 (describing the previously known and inferior PPARs modulators as agonists), page 21, lines 16-19 (describing the use of the inventive compounds to identify new PPAR agonists), page 170, lines 9-13 and 20-21 (describing the use of known tritium-labeled PPAR α agonists as radioligands for generating displacement curves, IC₅₀ values and transfection efficiency standards by which the inventive compounds are measured), page 173, lines 5-8 (describing a study in which the effects on plasma glucose of administering various dose levels of compounds of the present invention are compared with those of the PPAR gamma agonist rosiglitazone (BRL49653) and the PPAR alpha agonist fenofibrate).

Reconsideration and withdrawal of the restriction requirement is requested.

Claim Objections

Claims 4, 46 and 101 are objected to as containing non-elected subject matter.

Applicants amended Claims 4, 46 and 101 to delete the subject matter not elected by the response filed on February 26, 2008 in response to a restriction requirement.


Reconsideration and withdrawal of the restriction requirement is requested.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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